REMARKS

Claims 1 to 8, 10, 12 to 19, 21, 23 to 28, 30 to 38, 42 to 49, 51, 53 to 58, and 60 to 72 are pending in this application and are rejected under 35 U.S.C. § 103(a). No claim is herein amended. Applicant requests reconsideration of the rejection in light of the following remarks.

Rejection under 35 U.S.C. § 103(a)

Claims 1 to 8, 10, 12 to 19, 21, 23 to 28, 30 to 38, 42 to 49, 51, 53 to 58, and 60 to 72 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over US-B-6,823,526 ("Howard patent"). Applicant traverses the rejection because the Howard patent does not disclose, teach, or suggest all of the elements of applicant's claimed invention – including ***no input or step includes information identifying the user***, as required by independent claims 1, 14, 25, 31, 44, 55, and 61 – and there is no disclosure, teaching, or suggestion to modify the cited reference to reach applicant's claimed invention, as urged by the Office.

Applicant submits that it has not been established in the Office Action that the claimed invention is *prima facie* obvious. More particularly, there is no motivation to register a product with a manufacturer without providing personal identifying information. To establish a proper *prima facie* rejection, the following elements must be shown:

(1) the reference(s) is (are) available as prior art against the claimed invention;

(2) the motivation (explicit or implicit) provided by the reference(s), common sense, or common knowledge that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;

(3) a reasonable expectation of success;

(4) the basis for concluding that the claimed invention would have been obvious to do or obvious to try when there are only a finite number of identified, predictable solutions; and

(5) the reference(s) teach(es) the claimed invention as a whole.

KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007).

Applicant submits that all of the above elements have not been established. Hence, a *prima facie* obviousness rejection is improper.

The Office cites column 7, lines 36 to 40 of the Howard patent as the basis of the obviousness rejection relying on, which describes standard software (an installer 22) that is installed in a computer when a new device such as a printer is installed:

> The installer 22 may also interactively provide the user with merchandising information associated with the external device 30, ***such as verification of warranty registration*** and software license agreements.

The Office acknowledges that the Howard patent does not expressly disclose registering the device with the manufacturer. The Office asserts that the fact that Howard patent teaches "checking the registration of any warranty would make it obvious to at least attempt [to] register the warranty (*i.e.*, notify the manufacturer) according to the wishes of the user if no warranty is found to be registered." Office Action, page 4.

Applicant acknowledges that it is known to register a product, including using the internet, with a manufacturer in the background of the application:

> **[0011]** When a consumer purchases a computing product, such as a computer, printer, modem, or software package, it is often necessary or desirable for the consumer to register the product with the product's manufacturer before the first use of the product. Registration of such a product typically requires the product owner to provide personal identifying information – such as the owner's name, address, and telephone number – on a printed form that is mailed or faxed to the manufacturer, or on a web-based form that is transmitted to the manufacturer over the World Wide Web. Similarly, users are typically required to register with online services, such as web-based services for purchasing event tickets, downloading electronic coupons, or storing digital photographs in online albums, before first using such services. Such registration processes typically require the user to provide personal identifying information similar to that required for product registrations.

As noted in the background, the ***prior art methods including supplying personal identifying information to the manufacturer***, for example, via a postcard, fax, or web-based form. Applicant's claims require that no personal information is included in the input or registration request message. The Howard patent itself is silent with respect to how the verification of the warranty registration would be carried out and the Office has not pointed to any motivation in the reference itself or combination with other references or common sense or common knowledge that would teach or suggest registering the device ***without information identifying the user*** in any input or step. Applicant submits that the Office is engaging in the impermissible hindsight construction of the applicant's claimed invention and is not applying the correct test for obviousness. Furthermore, since all of the prior art methods utilize the personal information to effect the registration, the prior art, including the Howard patent, teach away from the claimed invention.

In view of the foregoing arguments, applicant submits that the Office has failed to establish a proper *prima facie* obviousness rejection and, therefore, requests the Office to withdraw the rejection of claims 1 to 8, 10, 12 to 19, 21, 23 to 28, 30 to 38, 42 to 49, 51, 53 to 58, and 60 to 72 under 35 U.S.C. § 103(a) over the Howard patent.

Conclusions

Applicant requests:

(1) reconsideration and withdrawal of the rejection of the claims; and

(2) allowance of claims 1 to 8, 10, 12 to 19, 21, 23 to 28, 30 to 38, 42 to 49, 51, 53 to 58, and 60 to 72.

If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (404) 459-5642.

Date: October 5, 2007

/Wendy A. Choi/
Wendy A. Choi
Registration No. 36,697

WOODCOCK WASHBURN LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439